

REMARKS

Claims 1-17 are pending in the present application, and are rejected.

Claims 7-9 are herein canceled. Claims 1, 4-6 and 11 are herein amended. New claims 18-42 are herein added. No new matter has been presented.

Claims 1-17 are pending in the application. Claims 1-10 and 12-17 are rejected. Claim 11 is objected to.

Claim Rejections - 35 U.S.C. §112

Claims 1-17 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The Examiner notes that the claims recite the limitation that the magnetic form must be greater than .5 mm in dimension. The Examiner asserts that this limitation is not supported by the specification because this new lower limit not immediately appreciated in the disclosure and only functions to circumvent certain prior art. The Examiner asserts that the specification recognizes lower limits of .005 mm and .001 mm but not .5 mm. The Examiner cites MPEP §2163 IB and §2163.05.

Applicants respectfully disagree with this rejection, and submit that the Examiner is analogously basing this rejection on “genus/species” rejections.

As the Examiner notes, Applicants clearly provide support for a range including the lower limit of 0.005 mm. The range of “at least 0.5 mm” is clearly inside the range encompassed by the range including a lower limit of 0.005 mm. Applicants submit that they are allowed to claim any range inside the disclosed range. Moreover, Applicants’ Examples 1 and 5 are directly read upon by the limitation.

Applicants admit that there are court decisions that support an argument that ranges found in the claim language must correspond exactly to ranges disclosed in the specification or parent. However, such cases are not in point, and each of the cases cited by the Examiner is similarly off-point. The facts in such cases precluded a determination that one skilled in the art could derive the claim limitations from the parent, due to a number of different factors, including the unpredictable nature of the art, In re Sichert, 566 F.2d 1154 (CCPA 1977); failure to distinguish one process from another, In re MacLean, 454 F.2d 756, (CCPA 1972); the addition of a critical limitation, In re Blaser, 556 F.2d 534, (CCPA 1977); failure to define a critical term, In re Lukach, 442 F.2d 967, (CCPA 1971); and use of a list that did not contain the claimed substance. In re Ahlbrecht, 435 F.2d 908, (CCPA 1971).

There is no requirement for a specifically disclosed data point that is otherwise inside a range supported in the specification. The Federal Circuit has said that what is required is, as of the filing date, that the inventor conveys with reasonable clarity to those skilled in the art that the inventor was in possession of the subject matter claimed. *Vas-Cath Inc. v. Mahurkar*, (Fed. Cir. 1991).

As the CCPA explained in *In re Wertheim*, 541 F.2d 257, 264 (C.C.P.A. 1976), another case involving ranges: "If lack of literal support alone were enough to support a rejection under §112, then the statement ... that 'the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112,' is empty verbiage. *Wertheim*, 541 F.2d at 265. As in the present case, in *Wertheim* the asserted claims covered a range ("solids level of at least 35%"), *id.* at 258, whereas the specification therein disclosed a broader range ("25 to 60% solid matter"), *id.* at 262. In *Wertheim*, the CCPA held that the specification supported the claimed range, even though the precise range of the claim was not repeated verbatim in the specification. In so holding, the court cautioned that it would "let form triumph over substance" if it allowed the written description requirement to eviscerate claims that are narrowed during prosecution, simply because the patent applicant broadly disclosed in the original patent application but then narrowed his claims during prosecution.

A similar case for assessing the facts of written description with ranges and combinations is *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, (Fed. Cir. 1985). In *Ralston*, a case in which the CAFC applied the less deferential 'clear error standard' appropriate for review of bench verdicts, the CAFC noted that the ranges in applicant's claims need not correspond exactly to those disclosed in the parent application. *Id.* at 1575. Rather, the CAFC clarified that the issue is whether one of skill in the art could derive the claimed ranges from the disclosure. Because of the fact-sensitive nature of the written description inquiry, the CAFC has often warned against misapplication of precedents in this area. Applicants respectfully submit that the Examiner is misapplying precedents in contravention of the warning of the CAFC.

Applicants therefore traverse the rejection under 35 U.S.C. §112, first paragraph.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-10 and 15-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over 4,859,255 to Fujimura in view of 7,163,591 to Kim and further in view of Beeby et al., “Micromachined Silicon Generator for Harvesting Power from Vibrations” or Gao et al., “Effects of the Degree of Grain Alignment on the Hard Magnetic Properties of Sintered NdFeB Magnets”.

The Examiner concludes that it would have been obvious based on the teachings of Kim to include a heat treatment step including dysprosium fluoride with the sintered form, after the initial sintering of the composition.

The Examiner concludes that it would have been obvious to produce a magnet with these dimensions as a matter of necessity.

Claims 12 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Fujimura in view of Kim and further in view of Beeby et al. or Gao et al. as applied to claim 1 above, and further in view of 5,286,366 to Mitsuji. The Examiner reasons that one would have desired to put several other layers on the exterior of the magnet, and would have first cleaned the exterior of the magnet with acid etching.

Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kim as applied to claim 1 above, and further in view of 6,777,097 to Hamada. The Examiner reasons that one would have shotpeened the exterior of the magnet to remove oxide layers.

Applicants herein amend claims 1, 4-6 and 11. Subsequently, Applicants respectfully disagree with the rejections because not all of the claimed limitations are taught or suggested by the cited combination of references, alone or in combination.

The lower limit 0.5 μm (magnetic anisotropy direction) is based on the description of Example 1 (page 18, lines 16-17). In the new claim 18, the lower limit 1.0 mm is based on the description of Example 4 (page 21, line 19). In claims 15 and 17, the lower limit 4 mm is also based on claim 1 (page 18, line 14).

Claim 1 is amended to remove the possibility that R is a fluoride, for which the Examiner depends on Kim et al. R^2 is one or more elements selected from among rare earth elements inclusive of Y and Sc, but is not a fluoride. Claim 1 also recites a lower limit of 0.5 mm its sintered magnet form, which has a dimension of at least 0.5 mm in a magnetic anisotropy direction.

Applicants note that the micro-structured powder of Kim et al. is used for bonded magnet, as is apparent from the description at column 4, lines 28-29 of Kim et al., which indicates that, "If the powders are larger than 500 μm , it is difficult to prepare a resin magnet using the above powders". Thus, Kim et al. at once teaches away from the present invention.

Claim 11 is amended to render it independent, it having already been indicated by the Examiner as containing allowable subject matter.

Claim 18 recites a dimension of 1 to 10 mm in a magnetic anisotropy direction, which includes a lower limit of 1.0 mm, which limit is neither taught nor suggested by the cited

combination of references, particularly Kim et al. Applicants submit that such lower limit is supported for similar reasons as in the description of claim 1, above.

Therefore, Applicants respectfully submit that claims 1, 11 and 18 are allowable.

Claims 2-10 and 12-17 depend from claim 1. Claims 19-32 depend from claim 11. Claims 33-42 depend from claim 18. Upon distinguishing claims 1, 11 and 18 as noted above, Applicants respectfully submit that each of the dependent claims should be allowable as well.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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